

REMARKS

Reconsideration of the above-identified application in view of the amendments above and the remarks following is respectfully requested.

Claims 1-63 are pending in the application. Claims 1-4, 7-8, 13-14, 17,23-25, 27,29-32, 43-44, and 53 have been amended. Claims 9-12, 28, and 63 have been withdrawn.

Priority Information

The Examiner has requested that the Applicant insert into the specification all related priority information. This information was previously submitted upon the filing of the application in the form of a Preliminary Amendment, and is available for viewing on the USPTO PAIR page.

Drawings

The Examiner has objected to the drawings under 37 CFR 1.83(a) because they fail to show descriptors as described in the specification. Corrected drawing sheets have been supplied.

Claim Rejections – 35 U.S.C. §102

The Examiner has rejected claims 27-42, 47-52 and 55-63 under 35 U.S.C. 102(e) as being anticipated by Chornenky et al. (6,994,706).

Claims 27 has been amended. Claims 28 and 63 have been withdrawn.

Claim 29 has been amended to introduce a structural element absent in Chornenky, namely a signal generator and a signal detector operable to detect a signal generated by said signal generator. Various claims dependent on claim 29 have also been amended.

With respect to the Examiner's response to original claims 47-51, referring in Chornenky to a guiding element 720 which comprises a signal transmitter and a template (722,724) which comprises a signal sensor (col. 5:49-54), the Applicant notes that in the

cited passage of Chornenky and in text immediately thereafter, Chornenky specifies that the sensors to which he refers are either thermal sensors (line 50) or monitors of electrical resistance of tissues (line 55). The claims of the instant application as now amended specify a signal generator and a signal detector operable to detect a signal generated by said signal generator. Such a pair of elements is clearly not anticipated nor suggested by Chornenky.

Claim Rejections – 35 U.S.C. §103

The Examiner has rejected claims 1-25, 43-46, and 53-54 under 35 U.S.C. §103(a) as being unpatentable over Chornenky et al. (6,994,706). Independent claims 1 and 24 have been amended and now specify method components using structural elements absent in Chornenky. Chornenky therefore does not suggest nor render obvious these claims, nor claims dependent thereon.

With respect to claim 53, the Examiner cites Chornenky's element 711 as being comparable to the element specified by claim 53, wherein the catheter is operable to be rendered stiff by introduction of pressurized fluid into an inflation lumen. Claim 53 has been amended to specify that the catheter is stiffened along that portion of its length which is positioned within the prostatic urethra, which is clearly dissimilar to Chornenky's element 711, which is a distal balloon designed to fix the distal end of his catheter in the bladder, and clearly does not stiffen portions of the catheter within the prostatic urethra.

With respect to claim 54, the Examiner cites Chornenky's element 727, yet that element is clearly dissimilar to the claim specification that the catheter is operable to be stiffened by insertion of an insertable stiffening element. Chornenky's element 727 does not serve to stiffen his catheter, indeed it is not part of his catheter at all.

In view of the above amendments and remarks, acceptance pending claims is respectfully and earnestly solicited.

Respectfully submitted,



Martin D. Moynihan
Registration No. 40,338

Date: October 6, 2008

Enclosures:

- Petition for Extension (3 Months)
- Replacement Figure Sheets
- Annotated Figures Sheets

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Applicant:

Shaike SCHATZBERGER

Serial No.: 10/517,768

Filed: December 27, 2004

For: METHOD AND APPARATUS
FOR POSITIONING A SURGICAL
INSTRUMENT

Group Art Unit:

3739

Attorney

Docket: 29097

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

LETTER TO CHIEF DRAFTSMAN

Sir:

Permission is requested to correct Figures 1, 2b, 3, 4, 5, 6, 7, 9, 11, 12, 13, 14, 15, 16a, 16b, 17, 19, 22, 23, 24 and 25 as shown in red ink on the attached photocopies.

Since the foregoing are all relative minor changes and do not include new matter, the formal drawings, which are being submitted herewith in an accompanying letter, include the above-requested changes.

Respectfully submitted,

Martin D. Moynihan

Martin D. Moynihan
Registration No. 40,338

Date: October 6, 2008

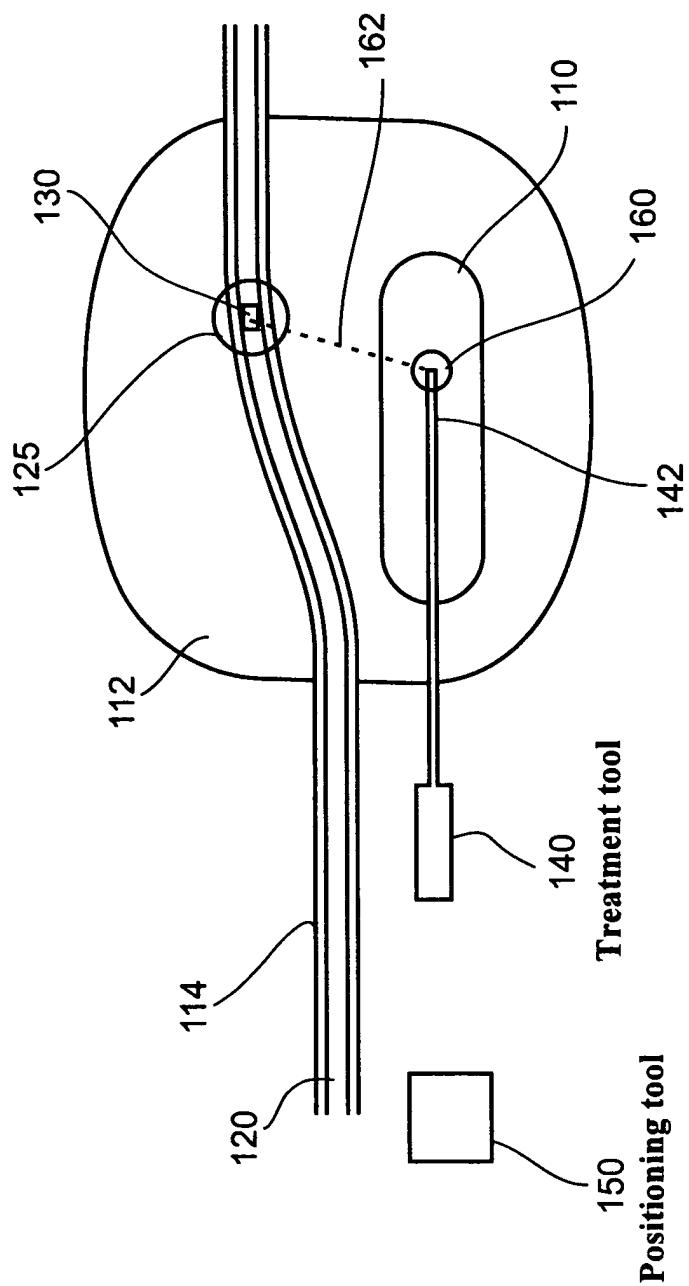


Fig. 1

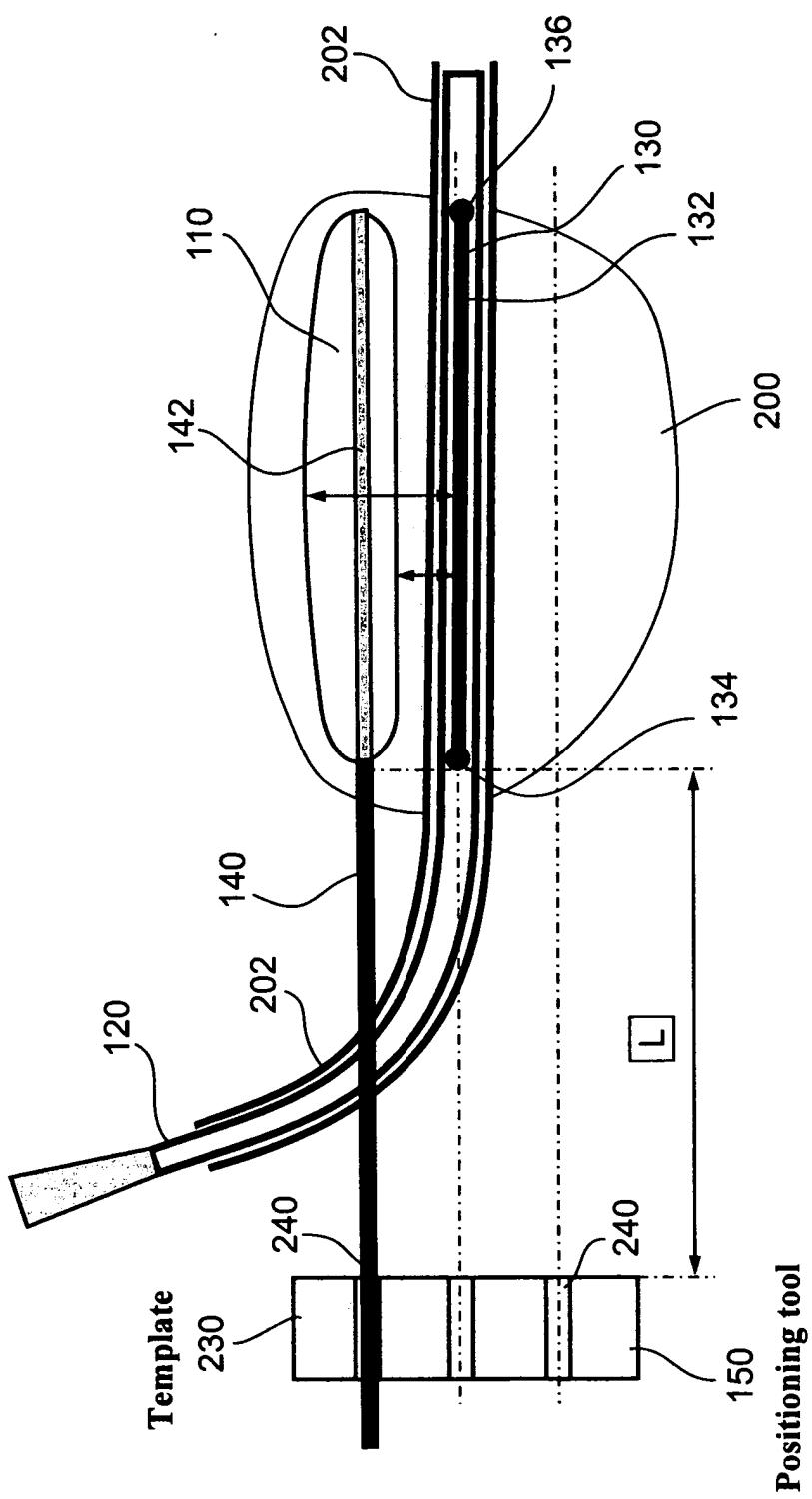


Fig. 2b

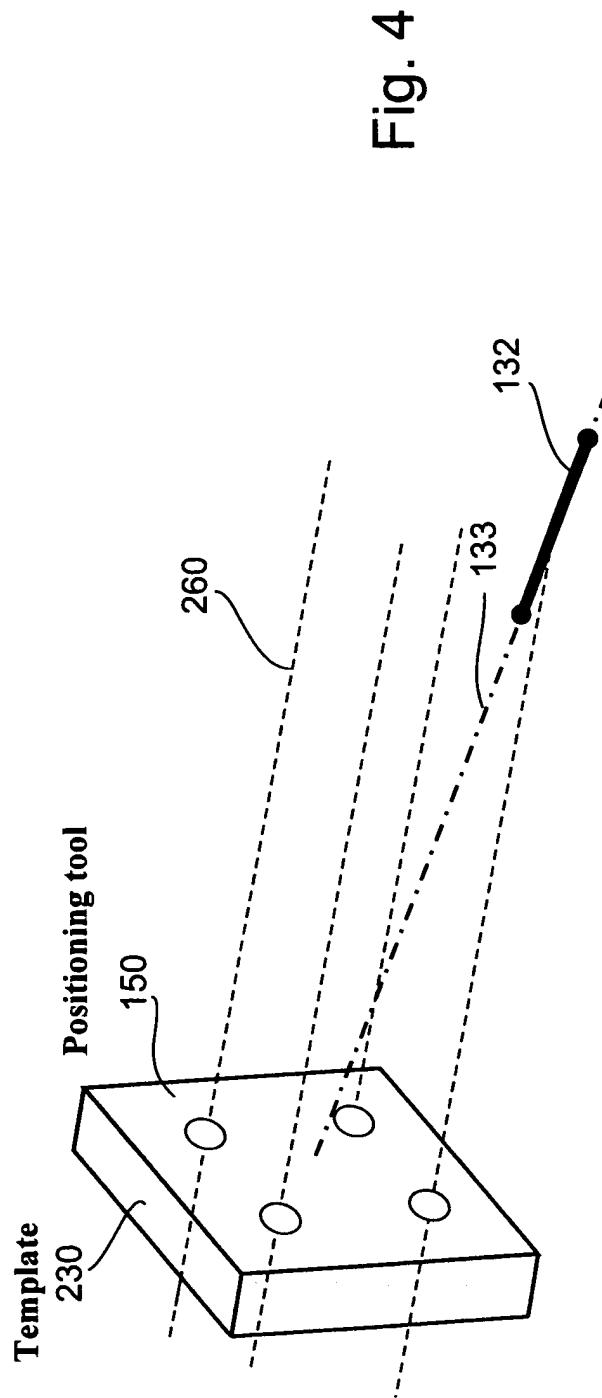
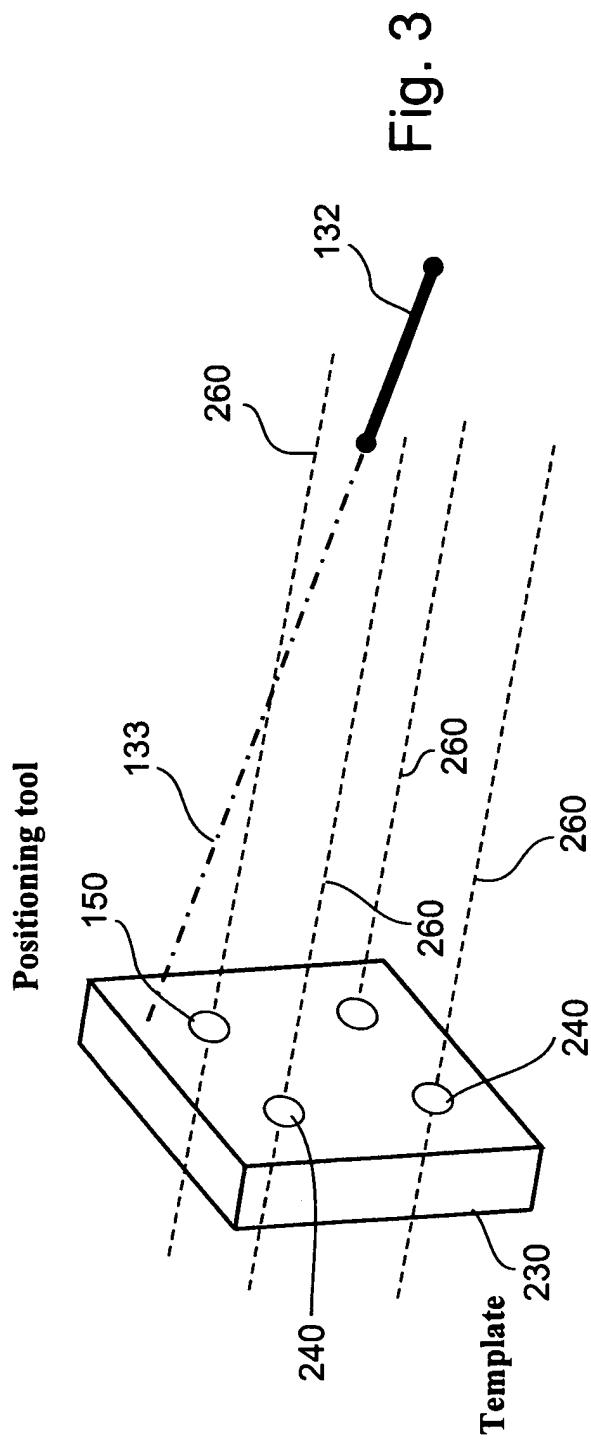
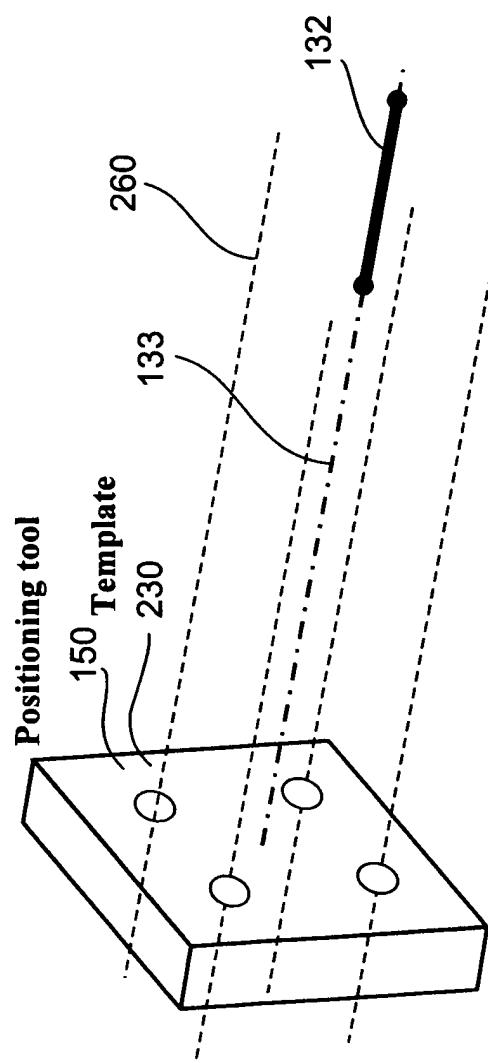


Fig. 5



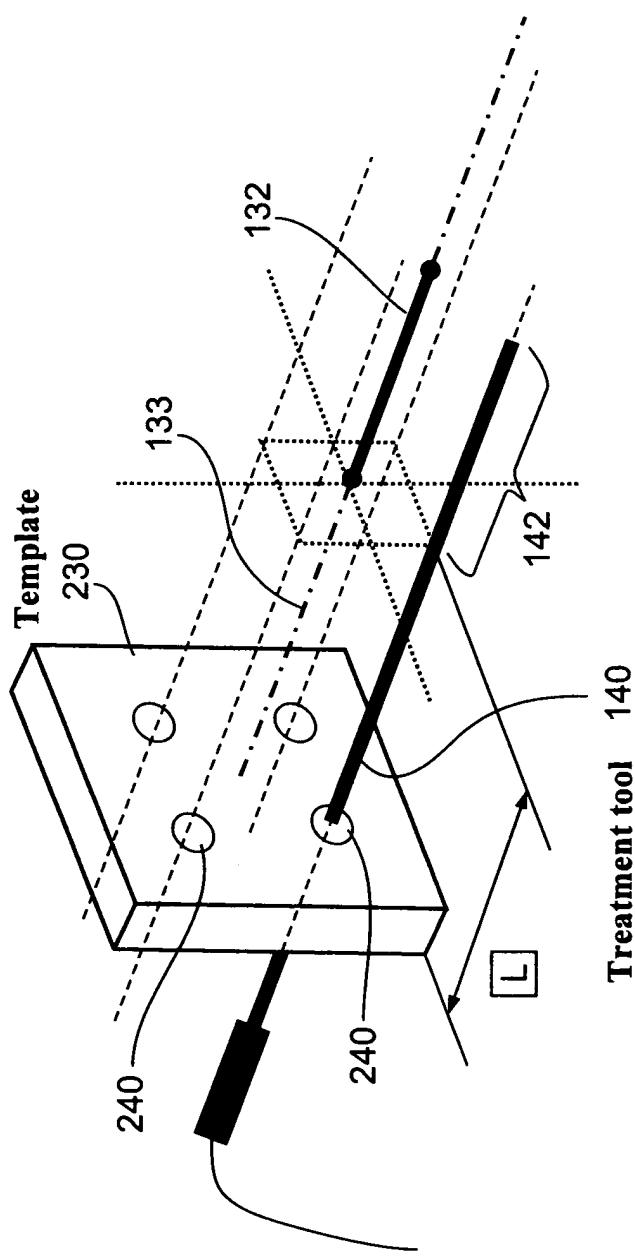
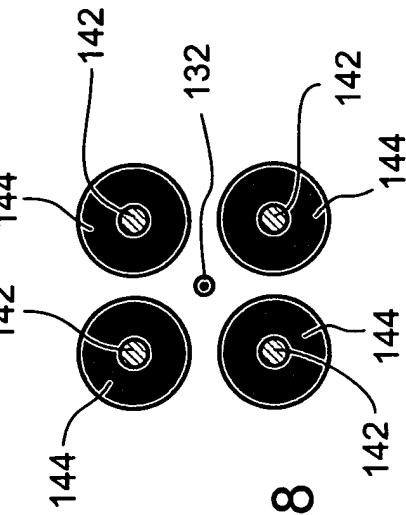
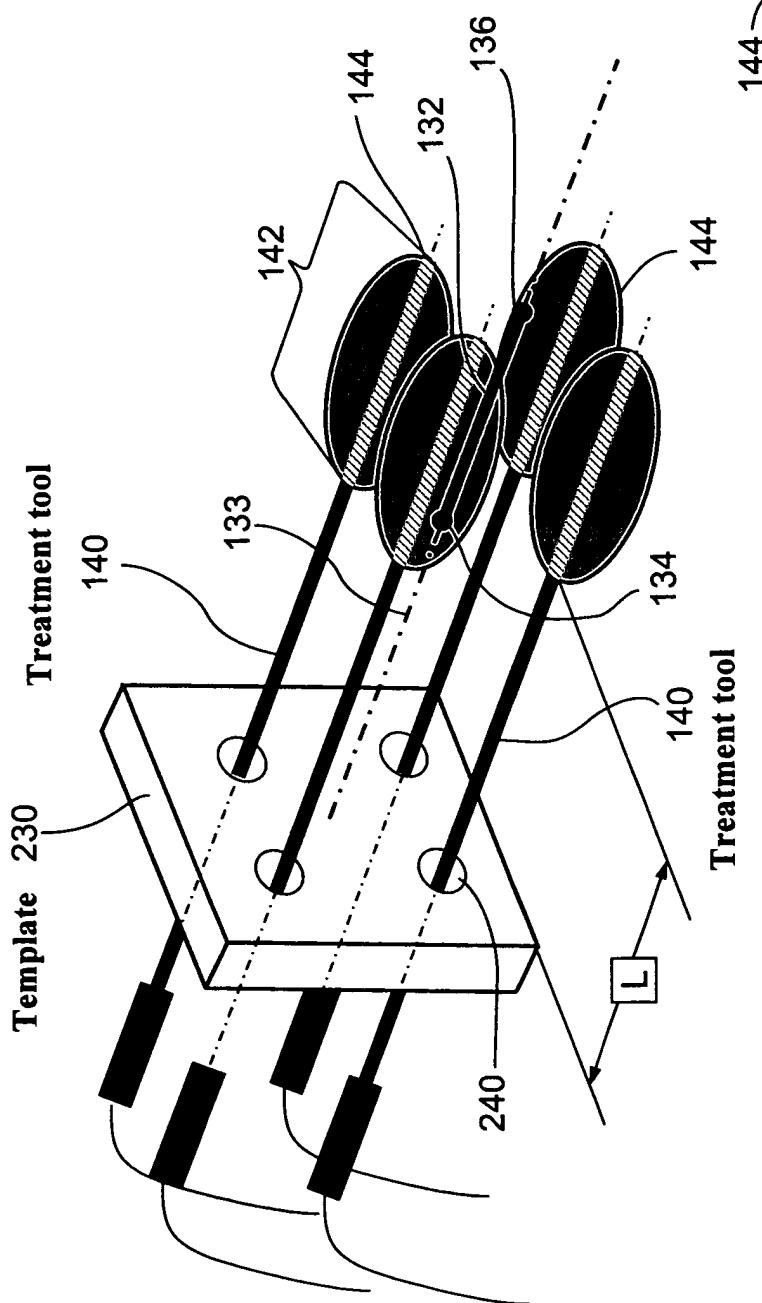


Fig. 6



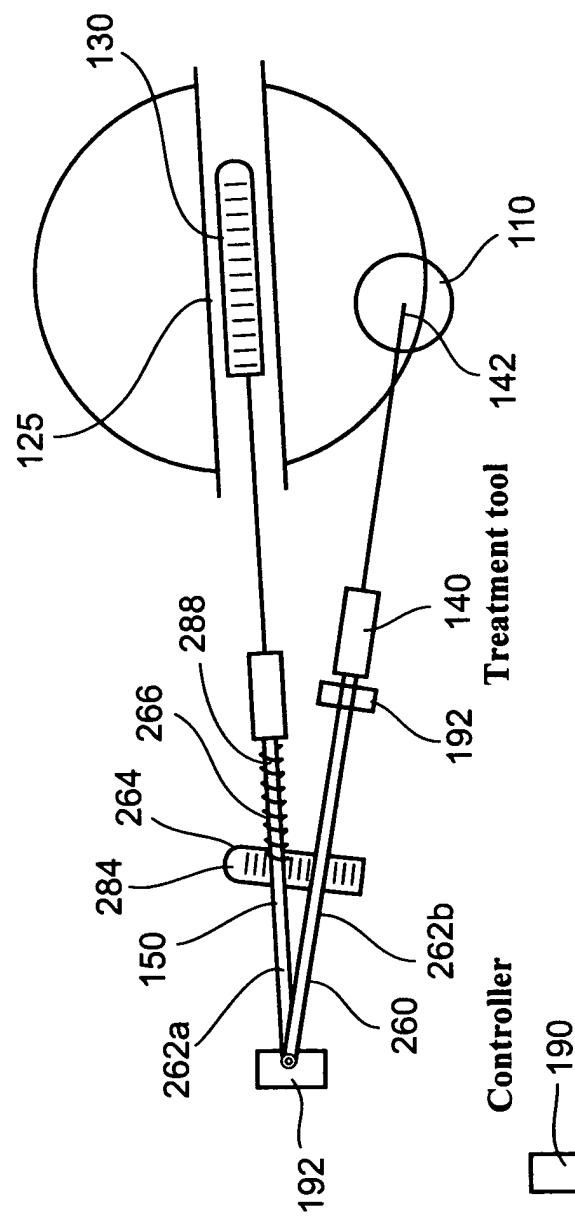


Fig. 9

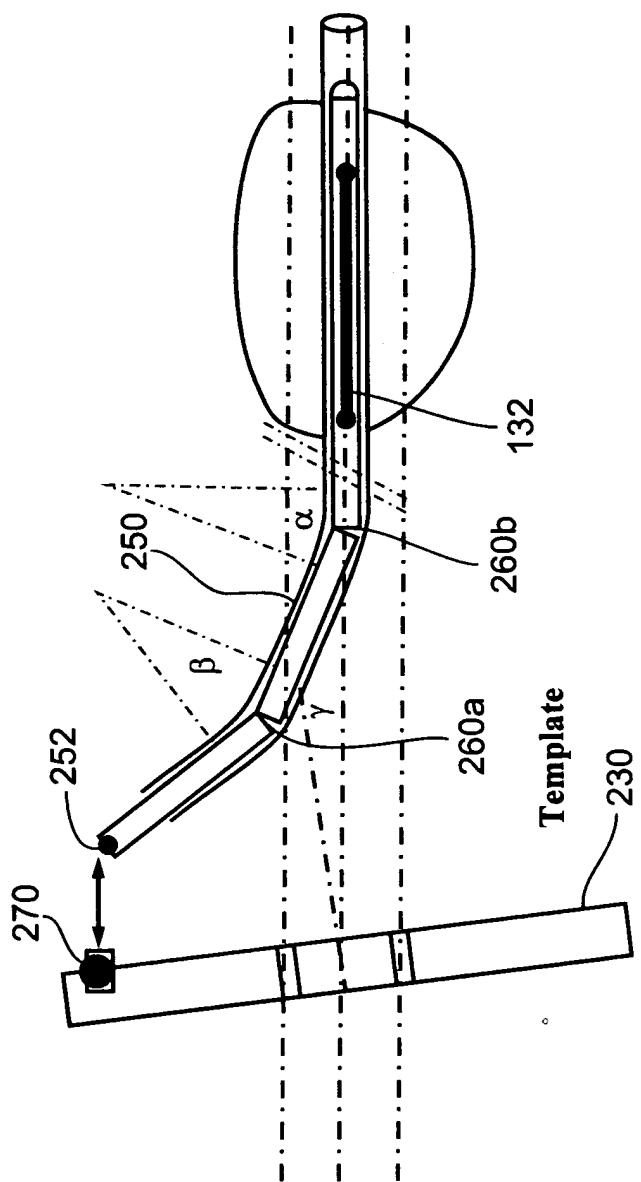


Fig. 11

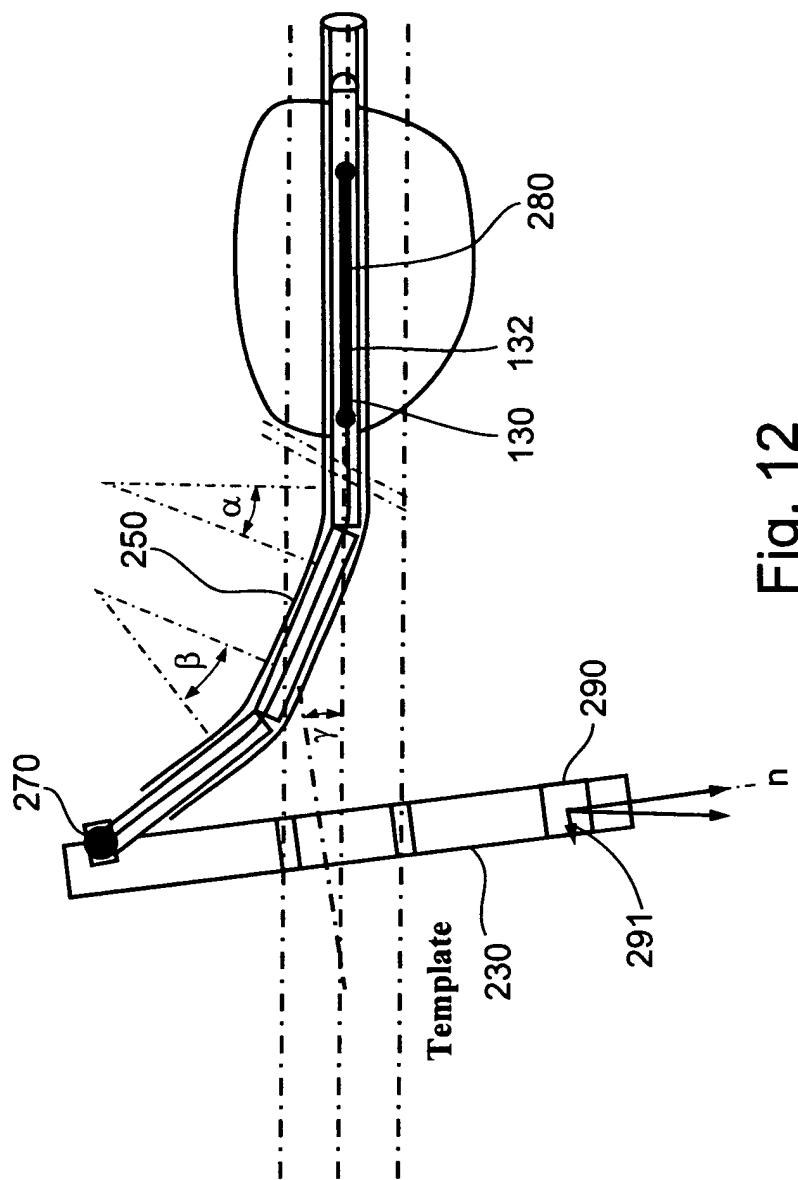


Fig. 12

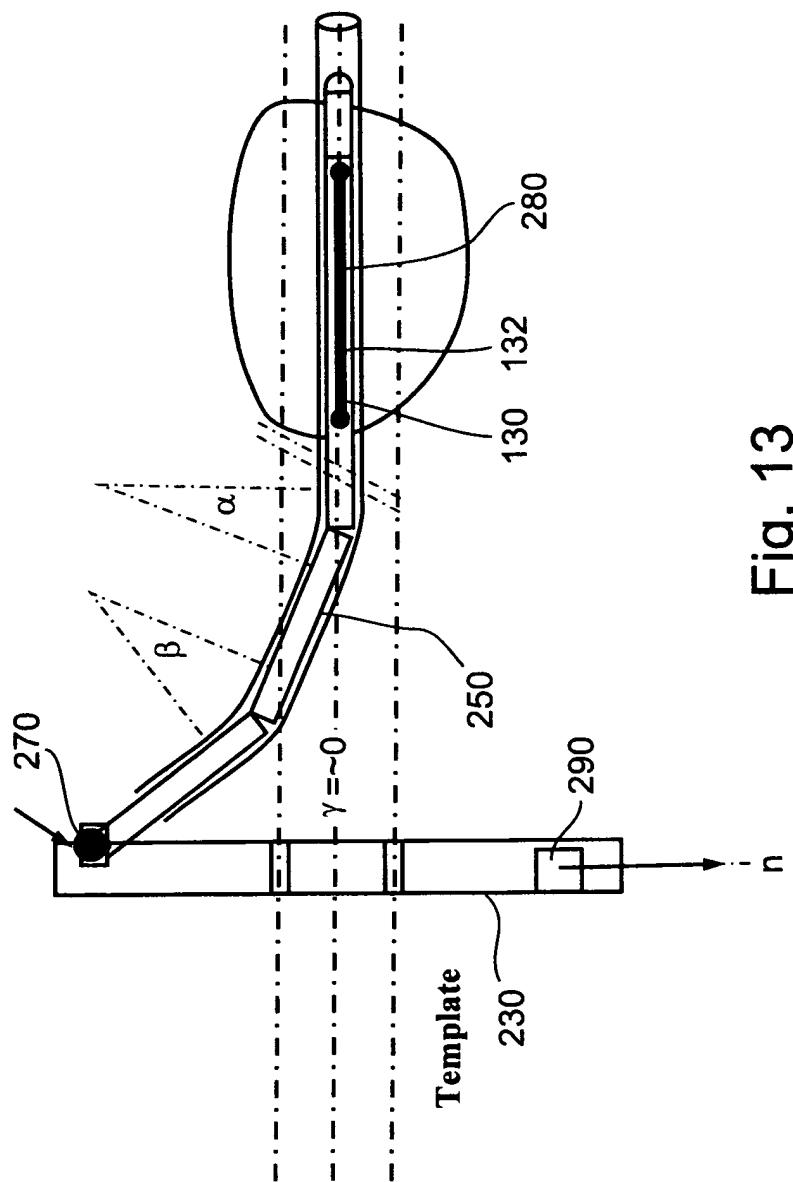


Fig. 13

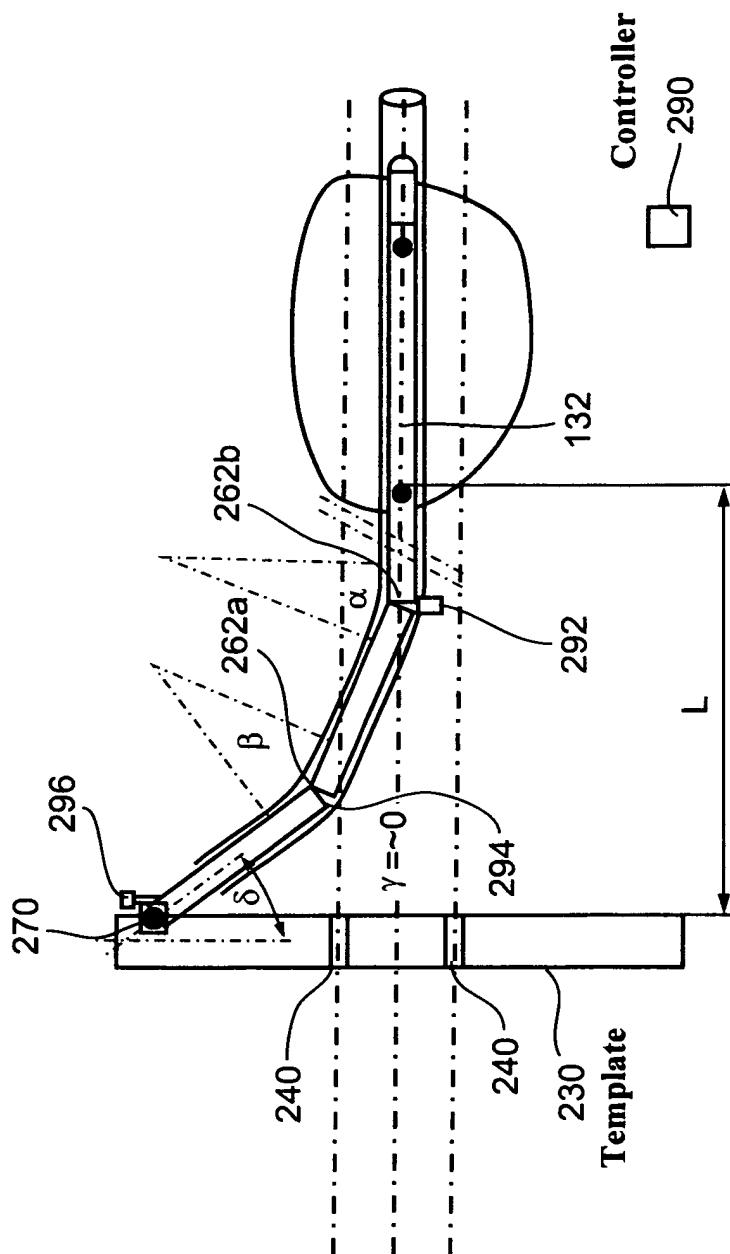


Fig. 14

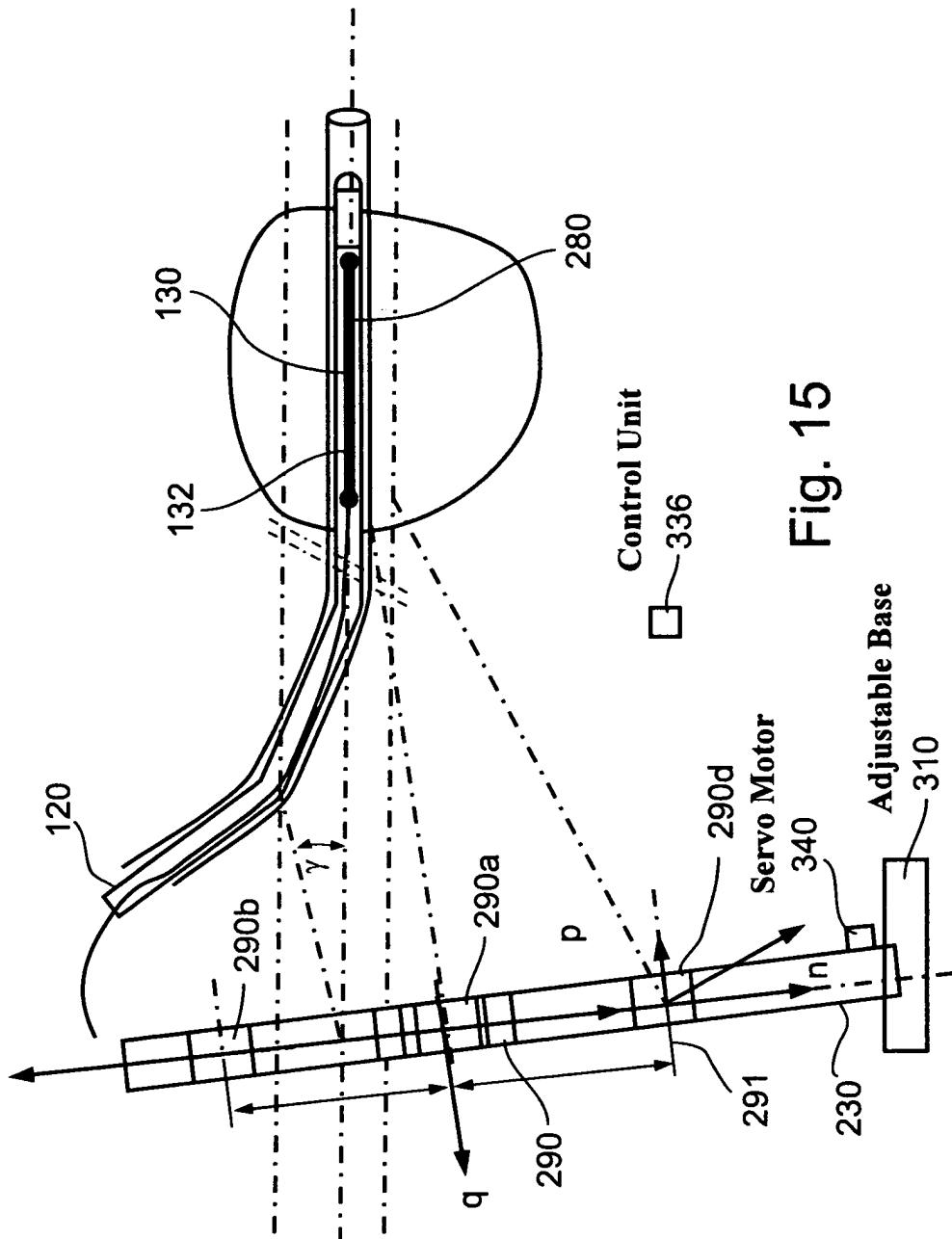


Fig. 15

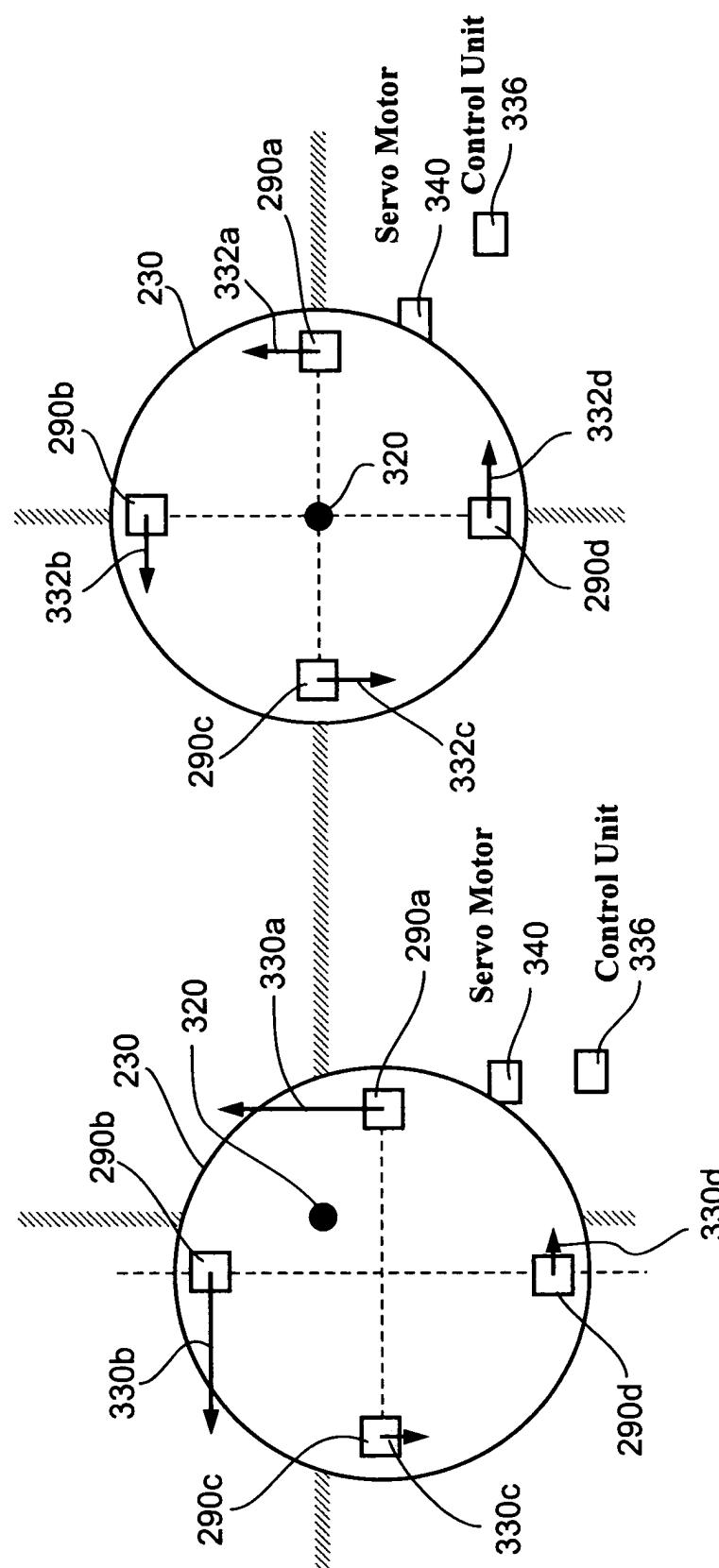


Fig. 16b

Fig. 16a

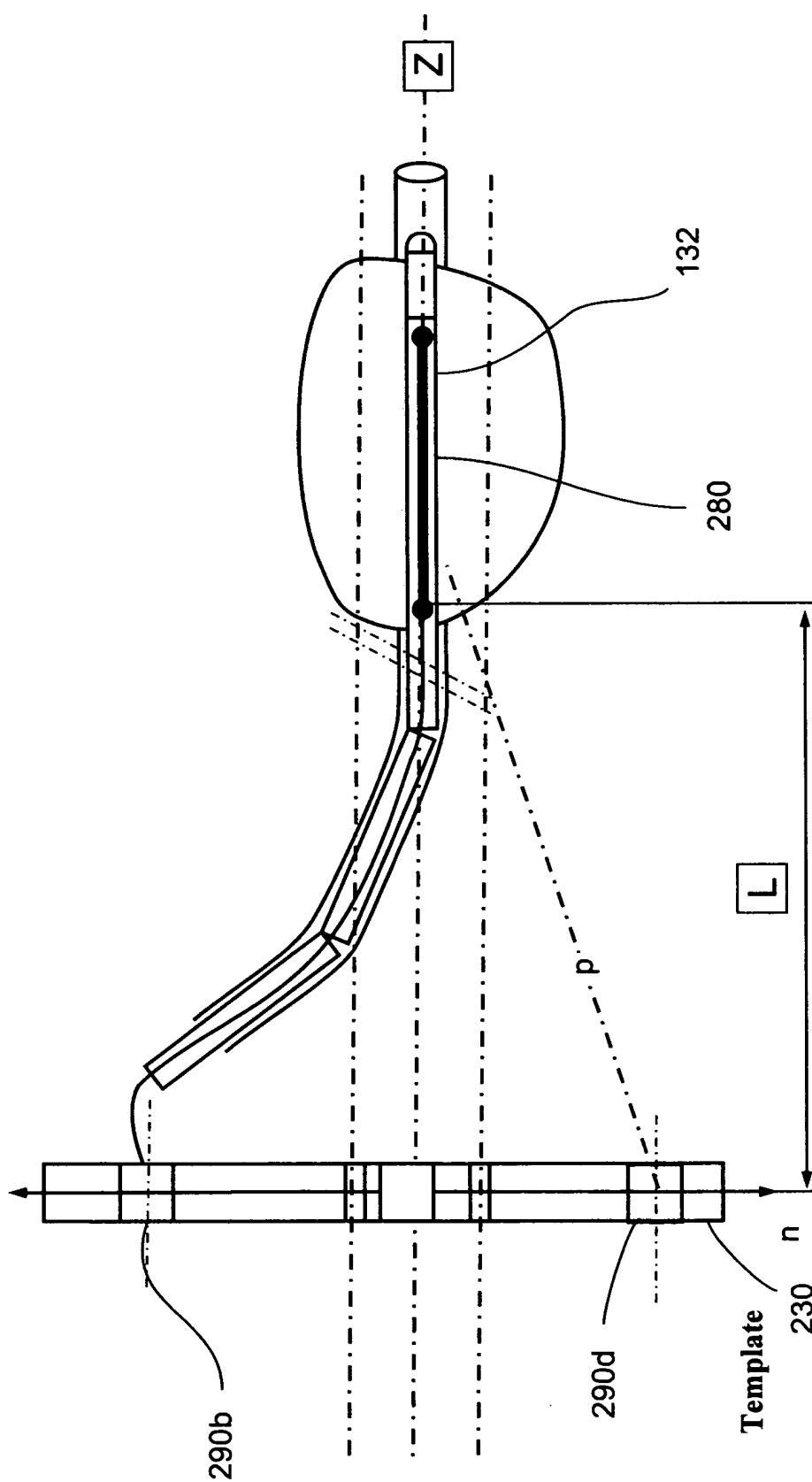


Fig. 17

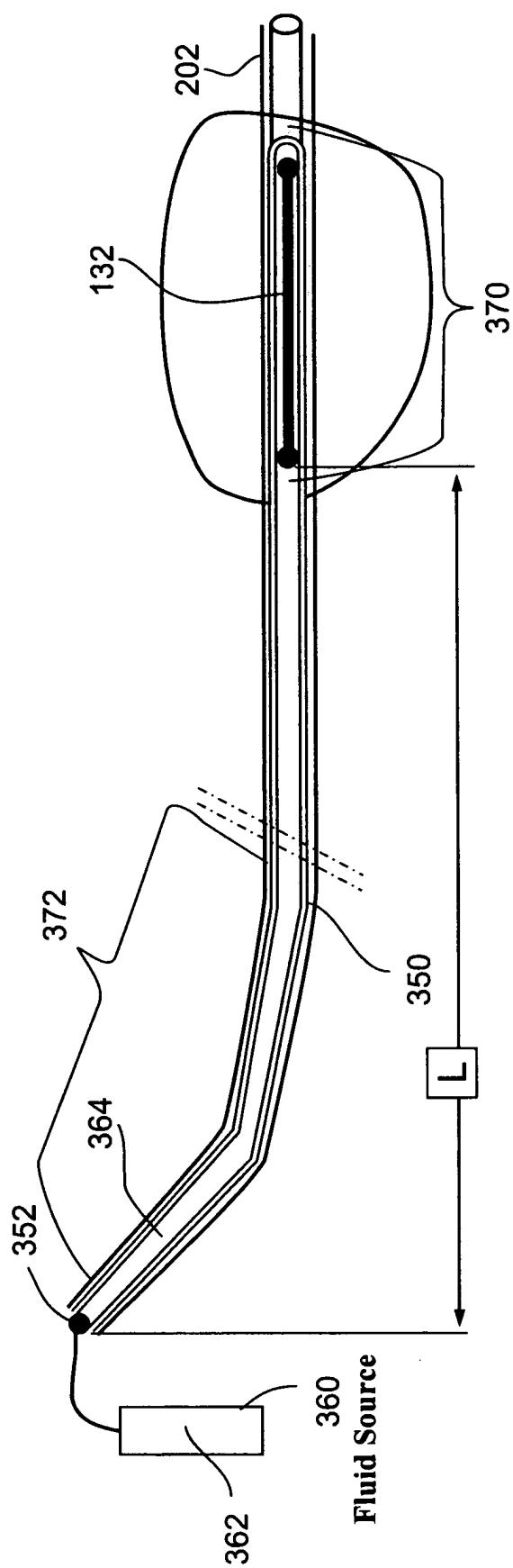


Fig. 19

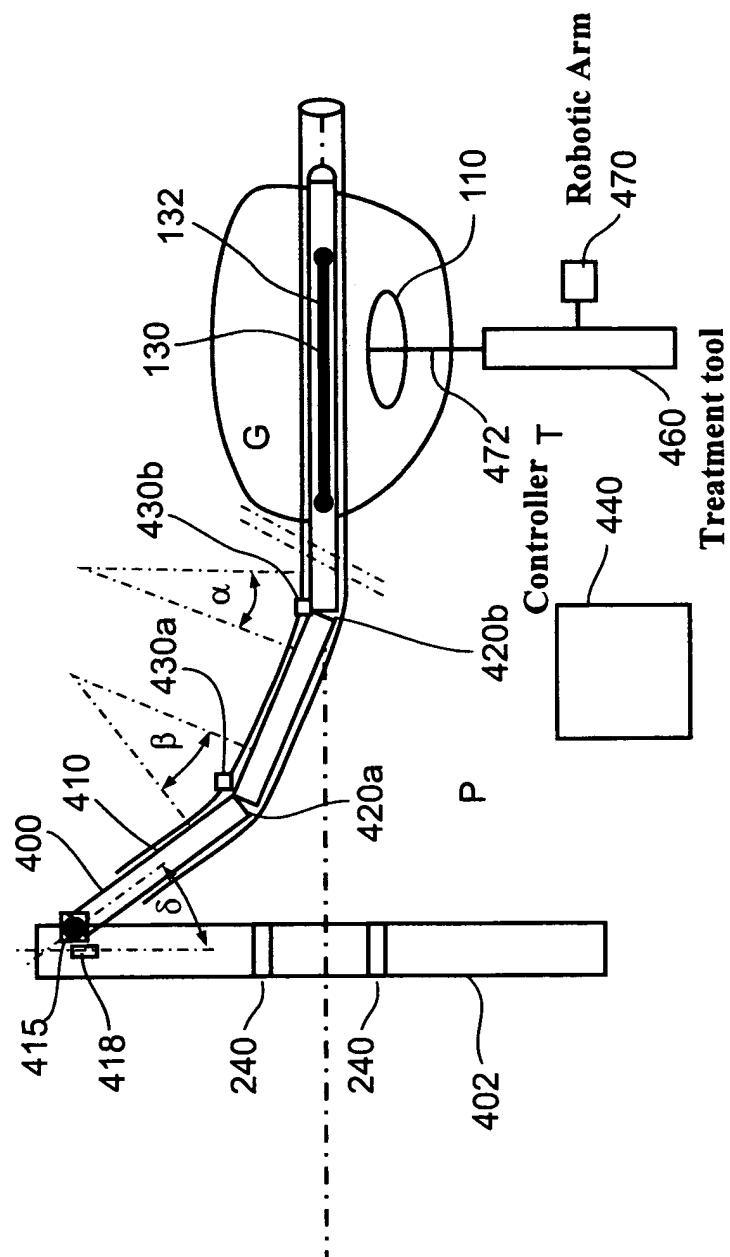


Fig. 22

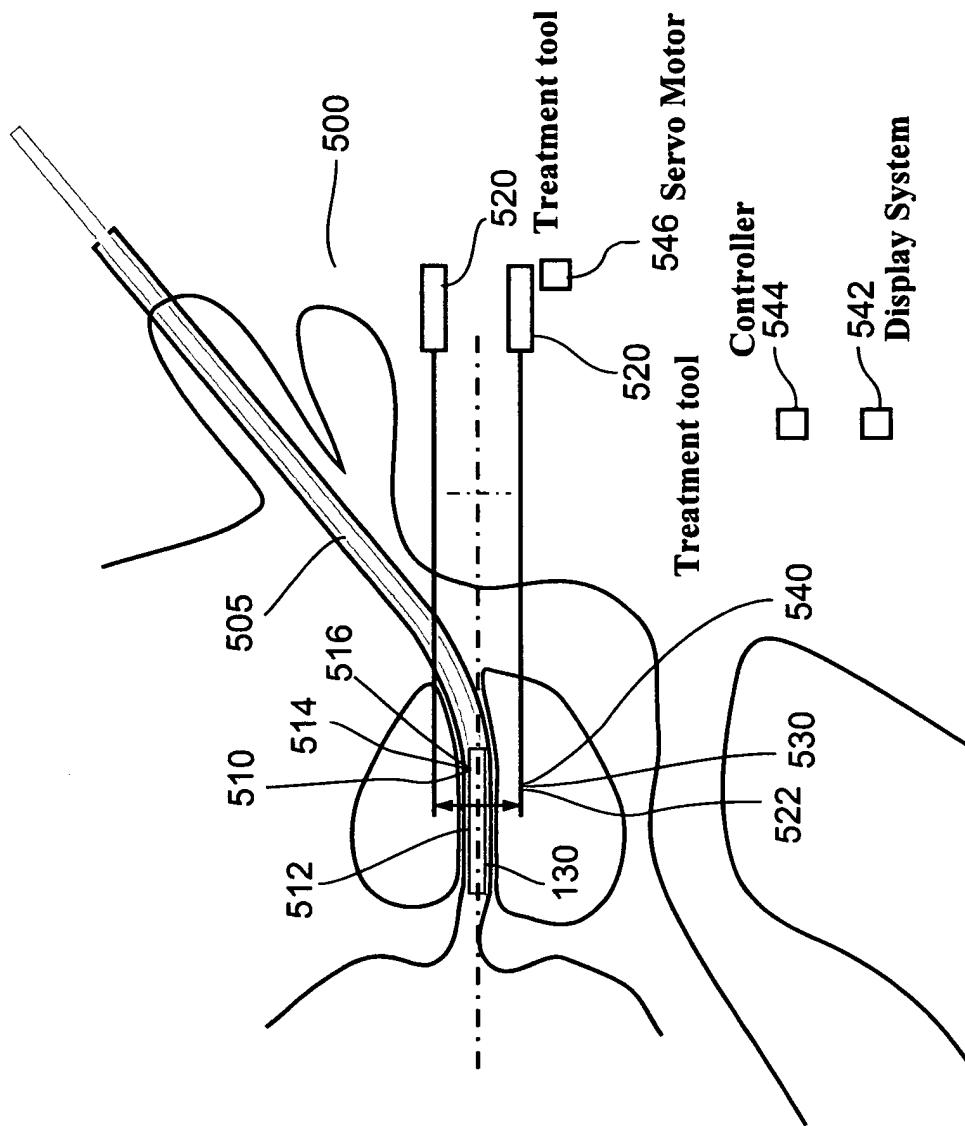


Fig. 23

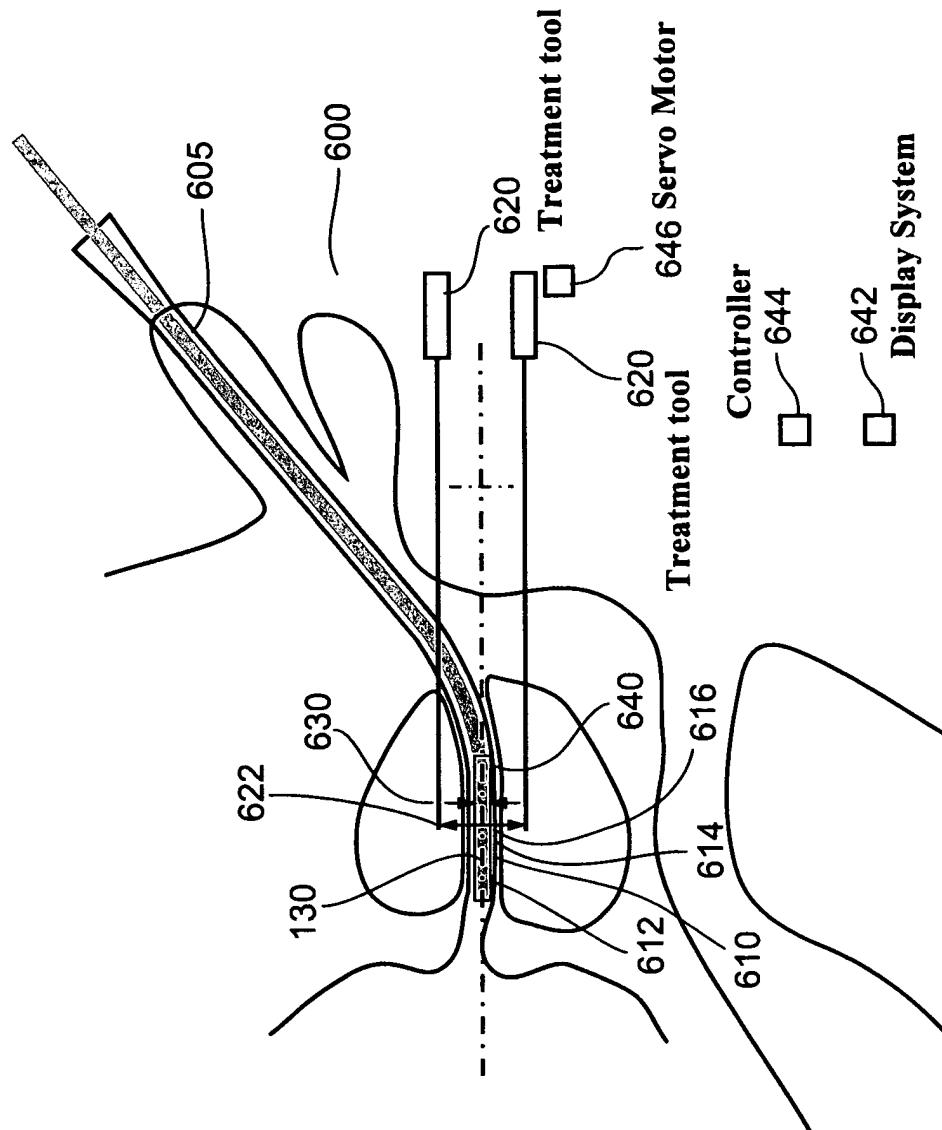


Fig. 24

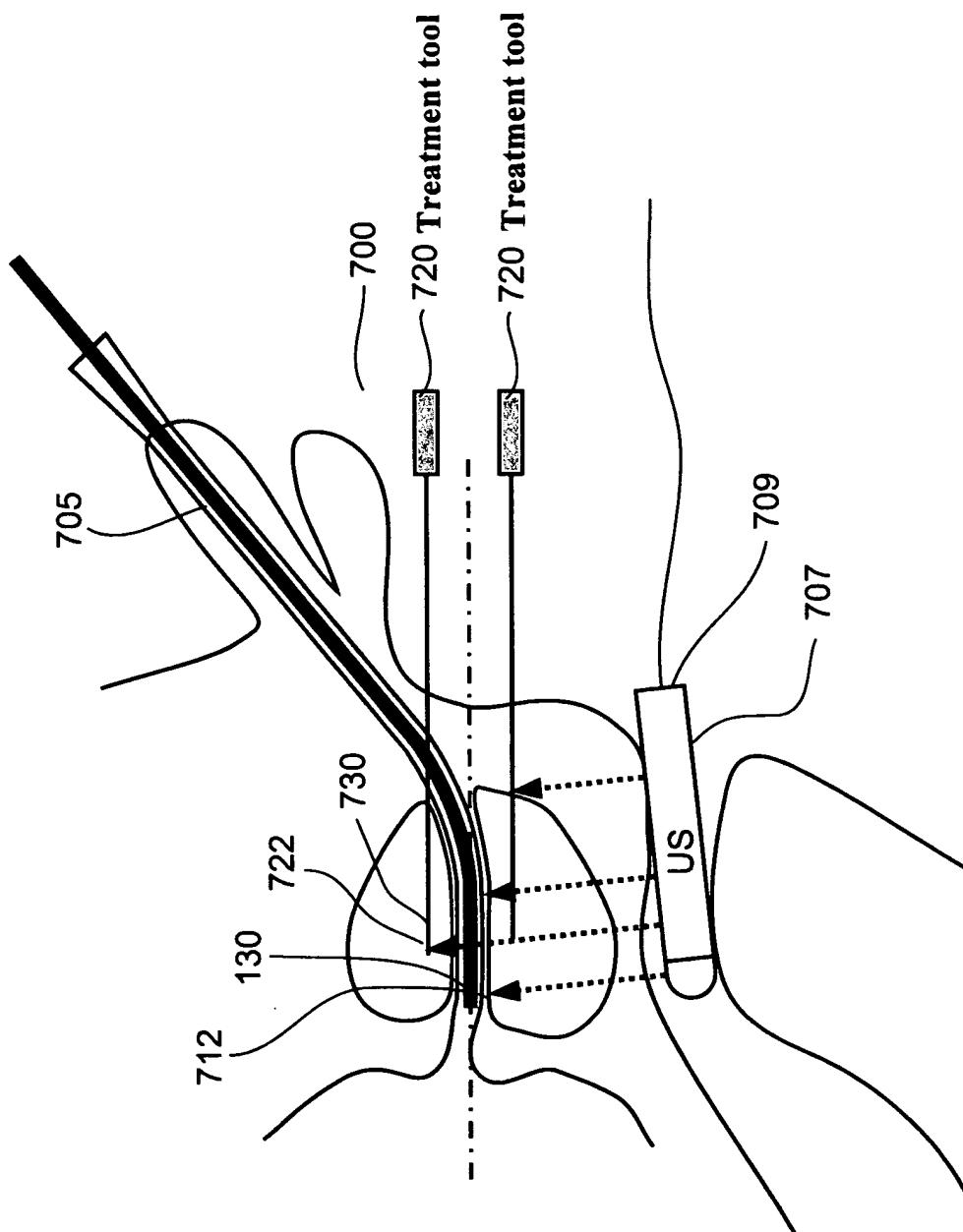


Fig. 25

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In re Applicant:

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Shaike SCHATZBERGER

Serial No.: 10/517,768

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For: METHOD AND APPARATUS
FOR POSITIONING A SURGICAL
INSTRUMENT

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Attorney
Docket: 29097



Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

FORMAL DRAWINGS

Sir:

We enclose herewith a new set of formal drawings (23 sheets) for the above-identified patent application.

Respectfully submitted,

Martin D. Moynihan

Martin D. Moynihan
Registration No. 40,338

Date: October 6, 2008